

REMARKS

In the Final Office Action ("FOA"), the Examiner objected to claims 13 and 14 as being dependent from a rejected base claim, but indicated that they would be allowable if rewritten in independent form including all the elements of the base claim and any intervening claims. By this Amendment, Applicants proposes rewriting claim 13 in independent form including all the elements of claim 9 and amending claim 11 to improve form. Thus, Applicants request that the Examiner enter this amendment and withdraw the objection to claim 13.

Moreover, claim 14 depends from allowable claim 13 and, thus, is allowable at least due to its dependence from claim 13. Therefore, Applicants request that the Examiner withdraw the objection to claim 14.

Further, the Examiner rejected claims 9-11 under 35 U.S.C. § 103(a) as unpatentable over Oguma, U.S. Patent No. 6,516,205 B1 ("*Oguma*"). In response, Applicants respectfully submit that a *prima facie* case of obviousness has not been established for claims 9-11 because *Oguma* fails to teach or suggest all the elements of these claims.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03, ed. 8, rev. 1 (Feb. 2003) (quoting *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. M.P.E.P. § 2143 at 2100-122 to 127.

Claim 9 is directed to a mobile communications terminal comprising a combination of elements including, *inter alia*, “interface selection means for selecting [a] first USB interface when it is determined by [a] first determination means that [an] external device comprises [a] second USB interface having [a] USB host function, and for selecting [a] serial data interface when it is determined by the first determination means that the external device does not comprise the second USB interface having the USB host function; and switching means for connecting the pins of the system connector with the first USB interface when the first USB interface is selected by the interface selection means, and for connecting the pins of the system connector with another serial data interface when the serial data interface is selected by the interface selection means .”

Oguma is directed to a portable terminal 5 that serves as a bus manager for an external USB device 6 or, when connected to a host computer, serves as a pass through. *Oguma*, Abstract. *Oguma* discloses that portable terminal 5 includes a voltage detection circuit 64, a level detecting circuit 61, a power supply switching circuit 65, a bus manager circuit 62, a hub unit 63, and a slave function circuit 66. *Oguma*, Fig. 3. The Examiner alleged that bus manager circuit 62 and hub unit 63 correspond to interface selection means as recited in the claims. (OA at 5.) Applicants submit that the Examiner has misconstrued *Oguma*.

In *Oguma*, bus manager circuit 62 and hub unit 63 serve to either connect lines 11 and 22 to lines 31 and 32 or connect lines 11 and 22 to slave function circuit 66. Portable terminal 5 can be connected to external device 6 via lines 31 and 32 and can be connected to a host PC 1 via lines 11 and 22. *Oguma*, Figs. 1 and 2. If portable terminal 5 is not connected to a host PC 1 external device 6, portable terminal 5 may serve as bus manager for external device 6 using bus manager circuit 62. *Oguma*, col. 4, l. 65 to col. 5, l. 44. If portable terminal 5 detects a signal

from host PC 1, portable terminal 5 does not serve a bus manager, and bus manager circuit 62 merely passes the signals from external device 6 to host PC 1. *Oguma*, col. 5, l. 45 to col. 6, l. 6. Alternatively, if portable terminal 5 is connected to PC 1 and external device 6, lines 31 and 32 are directly connected to lines 11 and 22. *Oguma*, col. 4 ll. 50-62. Thus, hub unit 63 only switches between slave function circuit 66 and lines 31 and 32.

Hence, *Oguma* fails to teach or suggest at least “interface selection means for selecting [a] first USB interface when it is determined by [a] first determination means that [an] external device comprises [a] second USB interface having [a] USB host function, and for selecting [a] serial data interface when it is determined by the first determination means that the external device does not comprise the second USB interface having the USB host function; and switching means for connecting the pins of the system connector with the first USB interface when the first USB interface is selected by the interface selection means, and for connecting the pins of the system connector with another serial data interface when the serial data interface is selected by the interface selection means,” as recited in claim 9. Accordingly, a *prima facie* case of obviousness has not been established for claim 9. For at least this, reason claim 9 is allowable.

The Examiner admitted that *Oguma* does not disclose an external connector with a plurality of connecting pins and a switching means for connecting the pins of *Oguma* with either a first USB interface or a serial data interface. Nonetheless, the Examiner took “Official Notice” that “plurality of pins” and “switching means” are well-known in the art. Thus, the Examiner concluded it would have been obvious to one skilled in the art “to provide *Oguma*’s external connector with a ‘plurality of pins’ for enabling connection with an external device; and so-called ‘switching means’ for enabling connection between wither a first USB interface or serial data interface and an external connector having an external device connected thereto after the

interface selection is made so that data can be transferred accordingly.” (OA at 3-4.) First, even if the Examiner’s allegations concerning well-known features were correct, which Applicants do not concede, Applicants submit that the Examiner’s conclusion of obviousness is erroneous. Specifically, modifying Oguma as alleged by the Examiner would render Oguma useless for its intended purpose.

Oguma illustrates that lines 11 and 12 are separately connectable from lines 31 and 32. *Oguma*, Figs. 2 and 3. Moreover, *Oguma* discloses that external devices, i.e., a host PC, connected to lines 11 and 12 of portable terminal 5 are limited to those having a USB host function and discloses that external devices, i.e., external device 6, connected to lines 31 and 32 are limited to those having a USB slave function. In other words, *Oguma* allows two devices, host PC 1 and external device 6, to be connected to portable terminal 5 such that host PC 1 can communicate with external device 6. However, if *Oguma* were to be modified as alleged by the Examiner, both PC 1 and external device 6 could not be connected to portable terminal 5 and communicate.

Specifically, if lines 11 and 12 and lines 31 and 32 were connected to a system connector by a switching means, only host PC 1 or external device 6 could be connected to portable terminal 5, and the operation of portable terminal 5 with both PC 1 and external device could not be achieved. *Oguma*, col. 5, l. 45 to col. 6, l. 6. Thus, the invention of *Oguma* would be rendered useless for its intended purpose. Accordingly, the Examiner’s conclusion regarding obviousness is improper. Hence, a *prima facie* case of obviousness has not been established for claim 9. For at least this reason, claim 9 is allowable.

Second, since the Examiner is relying on taking “Official Notice” in stating his conclusions of obviousness, the Examiner is respectfully reminded of the provisions of M.P.E.P.

§ 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An “Official Notice” rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based.

Applicants submit, in view of these requirements, that “plurality of pins” and “switching means,” as set forth in the claims, are not unquestionably well-known, and the Examiner has failed to demonstrate such. Considering the assertions on the record, it appears the Examiner is attempting to improperly rely on “Official Notice” as the basis upon which to justify the rejection. Accordingly, Applicants traverse the “Official Notice” taken and request that the Examiner withdraw the rejection and timely allow the pending claims. However, if the Examiner maintains his position that the pending claims are not allowable, Applicants request that the Examiner cite a competent prior art reference in substantiation of these unsupported conclusions and set forth a proper rejection based on factual evidentiary support that is made of record.

Claims 10 and 11 are allowable at least due to their dependence from allowable claim 9. M.P.E.P. § 2143.03 at 2100-126 (citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)).

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 13 and 14 in condition for allowance. Applicants submit that the proposed amendments of claim 13 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

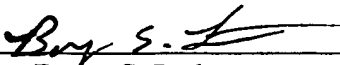
In view of the foregoing, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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